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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/717,567

11/21/2000

Paul A. Kohl

PRMSP0217USA

2128

7590

10/30/2006

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EXAMINER

MITCHELL, JAMES M

ART UNIT

PAPER NUMBER

2813

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 09/717,567	Applicant(s) KOHL ET AL.	
	Examiner James M. Mitchell	Art Unit 2813	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

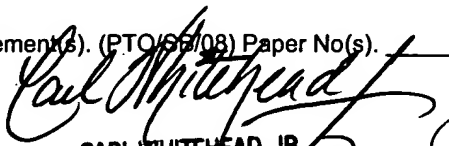
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SF/08) Paper No(s).
 13. ☐ Other: _____.


 CARL WHITEHEAD, JR.
 SUPERVISORY PATENT EXAMINER
 TECHNOLOGY CENTER 2800

Jmm/JD

Applicant's arguments filed October 2, 2006 have been fully considered but they are not persuasive. Applicant contends that Masaaki is not enabled and therefore does not disclose the claimed invention, because it is "well settled, a **patent** claim cannot be anticipated by a prior art reference....not enabled," and that Masaaki cannot be relied on because "it is not seen how a CVD process can form air gaps as shown in the drawings of Masaaki." [Emphasis added]. Although applicant has not cited any source for his contention about non-enabling references and patents, he is right in the context of an infringement proceeding and the invalidation of a patent, but not during the prosecution of a Patent application before the Patent Office.

Applicant's own quote reinforces this point, because it is the context of a **patent claim**. In the case at bar, the claim is drawn to a patent **application**, and therefore is not applicable. In addition, as applicant can readily appreciate, in an infringement proceeding before the CAFC more is shown in the way of proof to establish that a reference is not enabled than merely a statement that, "it is not seen [subjective opinion]" In the examination phase, since applicant's claim is a product and Masaaki discloses the structural features, the claim is anticipated. Again, the question of whether the reference (e.g. Foreign patent) is enabled is irrelevant in the examination phase; the USPTO is not the forum to challenge the enablement of a patent. Applicant is attempting to gain protection for a structure that has already been disclosed to the public, merely because he questions how the structure was formed. Pursuant to M.P.E.P 2125, a drawing can anticipate a claim and "it does not matter that the feature shown is....**unexplained**." [Emphasis added].

Lastly, applicant has challenged the presumption of validity given to a foreign patent, and in regards to the shape of the gap has stated, "the skilled person will appreciate that gap having upper sides that are parallel...will provide performance characteristics....different from those [tear drop shape]...by Avanzino." Even assuming that the USPTO was the correct forum to challenge the validity, applicant has done nothing more than present his own opinions on the validity or enablement of the patent without any evidence; this alone would not overcome the presumption. While applicant contends there is no presumption, examiner is unpersuaded. The presumption may be weakened, but it is not eliminated. See Bolkcom v. The Carborundum Co., 187 USPQ 466, 47 (CA 6 1975) ([W]here the applicable prior art has not been considered by the Patent Office [e.g. Foreign Patent] this presumption is greatly weakened).

Regarding the shape of the air gap (top parallel etc.), examiner has previously indicated that applicant's disclosure has not established the criticality or unobviousness of changing the shape. Yes, it is known that a change in shape of an air gap or spacing between metal lines will affect the dielectric between wiring layers and the performance (e.g. if too small than bridge could occur between wiring layers affecting **performance characteristics**); however, this is not an unobvious purpose. [Emphasis added]. Moreover, applicant has been provided with the opportunity to provide evidence other than his mere conjecture to overcome the prima facie case established by examiner, and he has failed to do so. See MPEP 2145 [R-3] ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). For the reasons

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stated above, applicant's arguments are found unpersuasive and the prior rejection deemed proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (571) 272-1931. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on (571) 272-1702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jmm, J.D.
October 13, 2006

